

**RECEIVED
CENTRAL FAX CENTER****FEB 22 2006****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

STEVEN C. JOHNSON et al.

HP Docket No. 10003562-1

Serial No. : 09/909,501

Examiner G. Neurauter

Filed : July 20, 2001

Group Art Unit 2143

For : ELECTRONIC SERVICE TRANSACTION AND METHOD

Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

DECLARATION UNDER § 1.131

We declare as follows:

1. We are inventors who, on July 20, 2001, filed the above-identified application. At the time of invention of the subject matter set forth in such application, we were employees of Hewlett-Packard Company.

2. In the December 27, 2005 Office action, the Examiner cites U.S. Publication No. 2002/0163662 to Kaufman et al. in rejecting all claims of the above-identified application.

3. U.S. Publication No. 2002/0163662 to Kaufman et al. claims the benefit of U.S. Provisional Application Serial No. 60/287,761 (filed May 1, 2001), and is a continuation-in-part of U.S. Patent Application Serial No. 09/642,538 (filed August 18, 2000).

Page 1 - DECLARATION UNDER § 1.131
Serial No. 09/909,501
HP Docket No. 10003562-1
KH Docket No. HPCC 3E2

4. Applicants expressly do not concede that either U.S. Provisional Application Serial No. 60/287,761, or U.S. Patent Application Serial No. 09/642,538, fully discloses the subject matter in U.S. Publication No. 2002/0163662 to Kaufman et al., or the subject matter claimed in the above identified application.

5. Prior to August 18, 2000, the earliest possible effective date of U.S. Publication No. 2002/0163662 to Kaufman et al., we conceived of our invention, and diligently worked toward reducing our invention to practice.

6. Exhibit 1, an HP Invention Disclosure form for an invention entitled "A Printer That Can Initiate (and Possibly Complete) an E-Service Transaction", was prepared prior to August 18, 2000, the earliest possible effective date of U.S. Publication No. 2002/0163662 to Kaufman et al.

7. At the time of preparing Exhibit 1, which preceded August 18, 2000, we had conceived of an electronic service transaction apparatus, comprising: a computer peripheral device having a communication link with an electronic service site; and a messaging system configured to communicate between the computer peripheral device and the electronic service site and operative to enable sending and receiving of at least one of messages and information between the computer peripheral device and the electronic service site, wherein the communication link connects the computer peripheral device with the Internet, and the computer peripheral device is configured to initiate an electronic service transaction with the electronic service site through self-access of the messaging system.

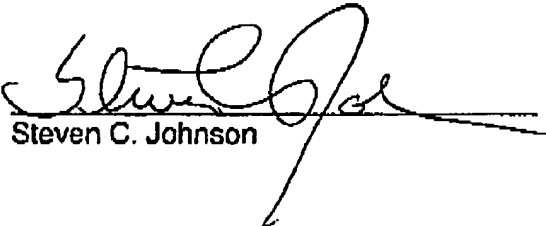
8. We also had conceived a computer peripheral device, comprising: an output engine; a transaction execution subsystem communicating with the output engine; a communication interface communicating with the transaction execution subsystem; and processing circuitry communicating with the transaction execution subsystem and operative to initiate an electronic services transaction through self-access from the transaction execution subsystem using the communication interface via an external network with an electronic services provider.

9. We also had conceived a method of initiating an electronic services transaction, comprising: providing a computer peripheral device having a communication link with an electronic service site and an interface system for initiating an electronic service transaction between the computer peripheral device and the electronic service site; detecting a need to initiate an electronic computer peripheral servicing transaction from the computer peripheral device with an external electronic service site; and initiating the electronic computer peripheral servicing transaction in response to the detected need using the computer peripheral device.

10. Following our conception prior to August 18, 2000, we diligently worked toward reducing our inventions to practice, and on July 20, 2001, filed the present patent application.

11. All acts set forth herein and/or relied upon for the purpose of establishing invention prior to August 18, 2000 were carried out in the United States.

12. We declare that all statements made herein of our own knowledge are true and all statements made on information and belief are believed to be true. These statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both under § 1001 of Title 18 of the United States Code. We understand that such willful false statements may jeopardize the validity of the application or any patent issuing therefrom.

Date: 2/15/06
Steven C. Johnson

Date: _____

Shane R. Konsella

Date: _____

Kwesi Abraham

Date: _____

Arti Shukla

Date: _____

Jessop T. Dennis

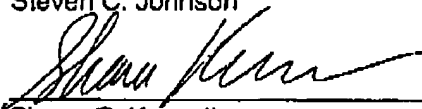

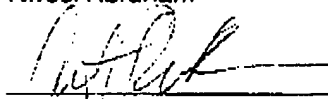
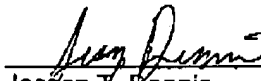
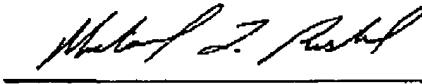
Date: _____

Michael L. Rishel

12. We declare that all statements made herein of our own knowledge are true and all statements made on information and belief are believed to be true. These statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both under § 1001 of Title 18 of the United States Code. We understand that such willful false statements may jeopardize the validity of the application or any patent issuing therefrom.

Date: _____


Steven C. Johnson

Date: 2/15/06
Shane R. KonsellaDate: 2/15/06
Kwesi AbrahamDate: 2/15/06
Ardi ShuklaDate: 2/15/06
Jessop T. DennisDate: 2/15/06
Michael L. Rishel

| INVENTION DISCLOSURE | | PAGE ONE OF _____ | |
|---|--------------------------|----------------------|------------|
| PDNO [REDACTED] | | DATE RCVD [REDACTED] | ATTORNEY |
| Instructions: The information contained in this document is COMPANY CONFIDENTIAL and may not be disclosed to others without prior authorization. Submit this disclosure to the HP Legal Department as soon as possible. No patent protection is possible until a patent application has been authorized, prepared, and submitted to the Government. | | | |
| Descriptive Title of Invention: A printer that can initiate (and possibly complete) an e-service transaction. | | | |
| Name of Project: [REDACTED] | | | |
| Product Name or Number: [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] | | | |
| <i>If any of the above situations will occur within 3 months, call your IP attorney or the Legal Department now at 1-898-4819 or 870-898-4915.</i> | | | |
| [REDACTED] [REDACTED] [REDACTED] | | | |
| Description of invention: Please preserve all records of the invention and attach additional pages for the following. Each additional page should be signed and dated by the inventor(s) and witness(es). A. Prior solutions and their disadvantages (if available, attach copies of product literature, technical articles, patents, etc.). B. Problems solved by the invention. C. Advantages of the invention over what has been done before. D. Description of the construction and operation of the invention (include appropriate schematic, block, & timing diagrams; drawings; samples; graphs; flowcharts; computer listings; test results; etc.) | | | |
| Signature of Inventor(s): Pursuant to my (our) employment agreement, I (we) submit this disclosure on this date: March 15, 2000 | | | |
| [REDACTED] | Steven C. Johnson | [REDACTED] | [REDACTED] |
| Employee No. | Name | Title | Mailstop |
| [REDACTED] | Shane R. Konzella | [REDACTED] | [REDACTED] |
| Employee No. | Name | Title | Mailstop |
| [REDACTED] | Kwesi Abraham | [REDACTED] | [REDACTED] |
| Employee No. | Name | Title | Mailstop |
| [REDACTED] | Arti Shukla | [REDACTED] | [REDACTED] |
| Employee No. | Name | Title | Mailstop |

(If more than four inventors, include additional information on another copy of this form and attach to this document)

Exhibit 1

| | | |
|---|-----------------------------|-------------------------|
|  | INVENTION DISCLOSURE | PAGE TWO OF ____ |
| PCNO | DATE RCVD | ATTORNEY |
| <small>Instructions: The information contained in this document is COMPANY CONFIDENTIAL and may not be disclosed to others without prior authorization. Submit this disclosure to the HP Legal Department as soon as possible. No patent protection is possible until a patent application is authorized, prepared, and submitted to the Government.</small> | | |
| Descriptive Title of Invention: A printer that can initiate (and possibly complete) an e-service transaction. | | |
| Name of Project: [REDACTED] | | |
| Product Name or Number: [REDACTED] [REDACTED] [REDACTED] [REDACTED] | | |
| <small>If any of the above situations will occur within 3 months, call your IP attorney or the Legal Department now at 1-800-4919 or 870-608-4919.</small> | | |
| [REDACTED] [REDACTED] [REDACTED] [REDACTED] | | |
| Description of Invention: Please preserve all records of the invention and attach additional pages for the following. Each additional page should be signed and dated by the inventor(s) and witness(es). A. Prior solutions and their disadvantages (if available, attach copies of product literature, technical articles, patents, etc.). B. Problems solved by the invention. C. Advantages of the invention over what has been done before. D. Description of the construction and operation of the invention (include appropriate schematic, block, & timing diagrams; drawings; samples; graphs; flowcharts; computer listings; test results; etc.) | | |
| Signature of Inventor(s): Pursuant to my (our) employment agreement, I (we) submit this disclosure on this date: [March 15, 2000]. | | |
| [REDACTED] Employee No. | Jassop T. Dennis Name | [REDACTED] Signature |
| [REDACTED] Employee No. | Michael L. Rishel Name | [REDACTED] Signature |
| [REDACTED] Employee No. | [REDACTED] Name | [REDACTED] Signature |
| [REDACTED] Employee No. | [REDACTED] Name | [REDACTED] Signature |
| [REDACTED] Employee No. | [REDACTED] Name | [REDACTED] Signature |
| <small>(If more than four inventors, include additional information on another copy of this form and attach to this document)</small> | | |

| INVENTION DISCLOSURE | | COMPANY CONFIDENTIAL | PAGE 3 OF |
|--|-----------|----------------------|-----------|
| Signature of Witness(es): (Please try to obtain the signature of the person(s) to whom invention was first disclosed.) | | | |
| The invention was first explained to, and understood by, me (us) on this date: [] | | | |
| Full Name | Signature | Date of Signature | |
| Full Name | Signature | Date of Signature | |
| Inventor & Home Address Information: (If more than four inventors, include addl. information on a copy of this form & attach to this document) | | | |
| Inventor's Full Name | | | |
| Steven C. Johnson | | | |
| Street | | | |
| City | | | |
| State | | | |
| Zip | | | |
| Do you have a Residential P.O. Address? P.O. BOX | | | |
| City | | | |
| State | | | |
| Zip | | | |
| Greeted as (nickname, middle name, etc.) | | | |
| Citizenship | | | |
| Inventor's Full Name | | | |
| Shane R. Konzella | | | |
| Street | | | |
| City | | | |
| State | | | |
| Zip | | | |
| Do you have a Residential P.O. Address? P.O. BOX | | | |
| City | | | |
| State | | | |
| Zip | | | |
| Greeted as (nickname, middle name, etc.) | | | |
| Citizenship | | | |
| Inventor's Full Name | | | |
| Kwesi Abraham | | | |
| Street | | | |
| City | | | |
| State | | | |
| Zip | | | |
| Do you have a Residential P.O. Address? P.O. BOX | | | |
| City | | | |
| State | | | |
| Zip | | | |
| Greeted as (nickname, middle name, etc.) | | | |
| Citizenship | | | |
| Inventor's Full Name | | | |
| Arti Shukla | | | |
| Street | | | |
| City | | | |
| State | | | |
| Zip | | | |
| Do you have a Residential P.O. Address? P.O. BOX | | | |
| City | | | |
| State | | | |
| Zip | | | |
| Greeted as (nickname, middle name, etc.) | | | |
| Citizenship | | | |

| HEWLETT-PACKARD INVENTION DISCLOSURE | | COMPANY CONFIDENTIAL | | PAGE 4 OF | |
|---|--|----------------------|--|-------------------|--|
| Signature of Witness(es): (Please try to obtain the signature of the person(s) to whom invention was first disclosed.) | | | | | |
| The invention was first explained to, and understood by, me (us) on this date: [] | | | | | |
| Full Name | | Signature | | Date of Signature | |
| Full Name | | Signature | | Date of Signature | |
| Inventor & Home Address Information: (If more than four inventors, include addl. information on a copy of this form & attach to this document.) | | | | | |
| Inventor's Full Name | | | | | |
| Jessep T. Denzle | | | | | |
| Street | | | | | |
| [REDACTED] | | | | | |
| City | | State | | Zip | |
| [REDACTED] | | [REDACTED] | | [REDACTED] | |
| Do you have a Residential P.O. Address? P.O. BOX | | | | | |
| City | | State | | Zip | |
| [REDACTED] | | [REDACTED] | | [REDACTED] | |
| Greeted as (nickname, middle name, etc.) | | | | | |
| [REDACTED] | | Citizenship | | | |
| [REDACTED] | | | | | |
| Inventor's Full Name | | | | | |
| Michael L. Rishel | | | | | |
| Street | | | | | |
| [REDACTED] | | | | | |
| City | | State | | Zip | |
| [REDACTED] | | [REDACTED] | | [REDACTED] | |
| Do you have a Residential P.O. Address? P.O. BOX | | | | | |
| City | | State | | Zip | |
| [REDACTED] | | [REDACTED] | | [REDACTED] | |
| Greeted as (nickname, middle name, etc.) | | | | | |
| [REDACTED] | | Citizenship | | | |
| [REDACTED] | | | | | |
| Inventor's Full Name | | | | | |
| Street | | | | | |
| [REDACTED] | | | | | |
| City | | State | | Zip | |
| [REDACTED] | | [REDACTED] | | [REDACTED] | |
| Do you have a Residential P.O. Address? P.O. BOX | | | | | |
| City | | State | | Zip | |
| [REDACTED] | | [REDACTED] | | [REDACTED] | |
| Greeted as (nickname, middle name, etc.) | | | | | |
| [REDACTED] | | Citizenship | | | |
| [REDACTED] | | | | | |

Description of Invention

Very soon, e-services will be abundant on the internet. This disclosure proposes the initiation of e-service transactions at the printer. This invention consists of:

- 1) Any e-service
- 2) A printer
 - a) connected to the internet
 - b) capable of initiating (and possible carrying out) an e-service transaction

Background

Prior Solutions and Disadvantages

Services are currently available on the internet. Customers can use a browser to access web-sites to find information, purchase goods, etc. However this model has several disadvantages:

1. These transactions are initiated manually by the user, through a web browser on the PC.
2. If the transaction is printer related, the user must be informed that a service exists and where to find it on the internet.
3. If the transaction is printer related, the user must know details about his particular printer model and configuration.
4. If the transaction is printer related, the user must track his own behavior and anticipate his own future needs.
5. Even if the transaction is printer related, the user chooses which services to conduct business with. His choice may not necessarily coincide with his exact printer model. Therefore, the printer manufacturer may not realize any financial advantage from this model. Also, the goods purchased may not be compatible with the user's exact printer model and configuration.

New Solution

This disclosure proposes the initiation (and possible completion) e-service transactions at the printer. This invention consists of:

1. Any e-service

Such an e-service will provide services either for free or for a fee. These e-services may or may not be print-related. The possibilities for e-services are nearly endless. Some examples of print-related e-services might include but are not limited to: scheduling maintenance, upgrading firmware, ordering consumables, downloading and/or printing manuals or other documents, upgrading the driver itself. Some examples of non print-related e-services might include but are not limited to: sending an e-mail to the system administrator, getting the latest stock quote for your favorite stock, getting the latest weather report, etc.

- 3) A printer
 - a) connected to the internet

This invention requires the ability for the printer to access (or cause another process to access) the internet to connect to and initiate a transaction with an e-service. This access could be provided through a dial-up access method, dedicated internet connection, or any other mechanism.

- b) capable of initiating (and possible carrying out) an e-service transaction

The printer is able to determine what e-service transaction(s) to initiate and when best to initiate the transaction. This could be based on 1) user input - where the user navigates menus on the printer's control panel or otherwise causes the printer to initiate e-service, 2) print-time printer state - where at print-time the driver initiates an e-service transaction based on the state of the printer and/or the contents of the current print job, or 3) statistical analysis - where the driver tracks the user's behavior over a period of time or over a set of print jobs to determine the user's needs. The e-service transaction could be initiated by a) simply launching a

Font: distributed electronically disclosure

printer-based web browser and pointing it to an e-service site where the user completes the transaction, b) connecting to the e-service and carrying out the entire transaction automatically with no user interaction, or c) any combination of a and b.

Example 1:

1. Suppose an e-service exists to render web pages and return them as PCL5 or PostScript print streams. (See related disclosure, "Universal Document Translation e-Service")
2. Suppose the user's printer is connected to the internet, and the user can point the printer to some document or web page on the internet and request that it be printed.
3. The printer would send the URL for the document or web page to the e-service and request that it be sent back to the printer as a print stream.
4. The printer prints the document or web page.

Example 2:

1. Suppose an e-service exists to sell laser printer toner. Normally, the user would have to learn that such a site exists (from print advertisements, television advertisements, etc.), and manually point his web browser to the site to conduct a transaction.
2. Suppose the user's printer is configured to access the internet.
3. Suppose the user's printer is instrumented to monitor the toner level in its cartridge.
4. The user configures the printer to automatically order toner from the e-service when the toner level falls to a certain level.
5. When the preset toner level is reached, the printer automatically connects to the e-service, and orders a the new toner cartridge

Advantages of New Solution

- E-services are made accessible without the need for a PC or other host computer.
- Transactions can be initiated at the place and time of need.
- The printer can be pre-configured to know where certain e-services exist on the internet.
- Print related transactions can be initiated by the printer, which has access to most or all of the information necessary to trigger (and possibly carry out) a transaction, such as printer model and configuration, state of the printer, contents of the current or past jobs, etc.
- The printer could track the user's behavior to determine which transactions to initiate and when to initiate them.
- E-services are made available to the user through a printer that he already has installed.
- Certain e-services to use can be pre-set to those provided by the printer's manufacturer, allowing that manufacturer to realize the financial advantages from the e-service.

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☒ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☐ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.